UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,883	08/02/2001	Shin Iima	450100-03386	5191

20999 7590 01/08/2008
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER	
LU, SHIRLEY	
ART UNIT	PAPER NUMBER
2612	
MAIL DATE	DELIVERY MODE
01/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHIN IIMA, HIROFUMI KANEMAKI

Appeal 2007-3059
Application 09/920,883
Technology Center 2600

Decided: January 8, 2008

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and KARL D. EASTHOM, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-14. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

This appeal includes a record that is not ripe for review and pursuant to 37 C.F.R. § 41.50(a)(1) (2007), we remand this application to the Examiner to take appropriate action consistent with our comments below. See 37 C.F.R. §§ 41.35(b) and 41.50(a)(1) (2007). The record is not ripe for review for the reasons noted below.

Appellants argue that they are entitled to a foreign priority date of August 3, 2000 based on Japanese Patent Application 2000-235220 (Br. 2). Without the foreign priority date, Appellants would be entitled to a filing date of August 2, 2001, the date Appellants filed their Application in the United States. Appellants claim the foreign priority date in order to overcome the United States filing date of a published non-provisional application to Kim (US 2002/0010927, filed Jan. 12, 2001) relied upon by the Examiner (Reply Br. 3). To rely on a foreign priority date to overcome the date of Kim's non-provisional application, Appellants must provide a certified translation of the document.

37 C.F.R. § 1.55 (a) 4(i)(B) (Claim for foreign priority.)(effective Jan. 16, 2007) provides:

> ....
> (a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, and 365 (a) and (b).
> ....
> (4)(i) An English language translation of a non-English language foreign application is not required except:
> ....
> (B) When necessary to overcome the date of a reference relied upon by the examiner....

Therefore, without a certified translation, under 37 C.F.R. § 1.55, Appellants cannot be granted a foreign priority date which means that they cannot argue that their foreign priority date overcomes the filing date of Kim's non-provisional application (US2002/0010927).[1]

[1] The Examiner relied upon Kim's published non-provisional application in a 35 USC § 103 rejection. Kim's published non-provisional application is

Moreover, the certified translation must support Appellants' claims under 35 U.S.C. 112. MPEP 201.15 (Rev. 6, Sept. 2007)(Right of Priority, Overcoming a Reference), states:

> In those cases where the applicant files the foreign papers for the purpose of overcoming the effective date of a reference, a translation is required if the foreign papers are not in the English language….
>
> If the priority papers are already in the file when the examiner finds a reference with the intervening effective date, the examiner will study the papers, if they are in the English language….If the papers are not in the English language and there is no translation, the examiner may reject the unpatentable claims and at the same time require an English translation for the purpose of determining the applicant's right to rely on the foreign filing date.
>
> ….
>
> *The most important aspect of the examiner's action pertaining to a right of priority is the determination of the identity of invention between the U.S. and the foreign applications....The foreign application must be examined for the question of sufficiency of the disclosure under 35 U.S.C. 112*, as well as to determine if there is a basis for the claims sought.

---

prior art under 35 USC § 102(e) (unless Appellants' claim to foreign priority is granted). In order to overcome Appellants' claim to a foreign priority date of Aug. 3, 2000, the Examiner further relied on the parent application to Kim's non-provisional application – Kim's US provisional application 60/176,121 - which has a filing date of Jan. 14, 2000. However, if Appellants are not entitled to the Aug. 3, 2000 foreign priority date (for lack of a certified translation), then the sole question raised by Appellants on appeal - whether or not Kim's provisional application supports the rejection advanced by the Examiner (Br., 8-9, Reply Br. 3-4, Ans. 19-21) - will become moot. That is, Kim's published non-provisional application - filed Jan. 12, 2001 before the filing date Aug. 2, 2001 of Appellants' U.S. application – is prior art under 35 USC § 102(e) and can be applied as such to any claims in Appellants' U.S. application that are not supported by a certified translation.

MPEP 201.15 (Rev. 6, Sept. 2007)(emphasis supplied).

By answering the question on Appeal as to whether or not Kim's provisional application is sufficient to support the rejection, the Examiner effectively has granted the right of foreign priority to Appellants, without examining the question of sufficiency as to Appellants' claims as required by MPEP 201.15. If Appellants' claims are not supported by the certified translation, then the sole question raised by Appellants on appeal is moot (see n.1 above). Consequently, on remand, the Examiner must determine from a certified translation supplied by Appellants whether or not the translation is sufficient under 35 USC § 112 to support Appellants' claims.

Finally, should the Examiner find that Appellants' translation supports the claims, and the Examiner therefore relies on the provisional application to Kim (US 60/176,121) to support the rejection, the Examiner should cause a copy of the provisional application to Kim to be made of record (i.e., scanned into EDAN and listed on a Form 892).

ORDER

Accordingly, it is ORDERED that the application is remanded to the Examiner:

1) to request a certified translation of Appellants' foreign priority document from Appellants

2) to determine from the certified translation whether or not the translation is sufficient under 35 USC § 112 to support Appellants' claims, and

3) if the Examiner continues to rely on Kim's provisional application (US 60/176, 121) to support the rejection, to cause Kim's provisional

application to be made of record (i.e., scanned into EDAN and listed on a Form 892); and

4) for such further action as may be appropriate.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the board.

REMANDED

eld

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE – 10th FL.
NEW YORK, NY 10151